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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,738	06/08/2001	Boris Viktorovich Moiseev	MOISEEV ET AL-1 PCT	9616

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,738

Applicant(s)

MOISEEV ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/30/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to communications filed on 2/21/2006.

Information Disclosure Statement

1. Some references in the IDS filed 3/30/06 were not considered for the following reasons: Internet, 2nd Edition lacks English translations and statements of relevance.

Specification

2. The amendment filed 2/21/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The first sentence of the last paragraph reads "Additionally an advertising information can be input by the user from the keyboard using an input unit (not shown on the figure)".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "change of consequence" is not understood, nor is clarification available in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **As best understood, Claims 41-44, 46-56, and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Gerszberg (U.S. Patent No. 6,292,210).**

Gerszberg shows an advertising information system that includes all of the limitations recited in the above claims.

Regarding claims 41, 42, 50 and 58, Gerszberg teaches a system including a user's device (which could be any number of devices) connected via a connection unit to a memory device (ISD, which examiner considers to act as a server) (Column 5, Lines 35-40). Also included into said system is a device for generating a set of

requested information and advertising information (television, which examiner also considers to be an information display board) (Column 9, Lines 27-33). It is inherent that a device for displaying advertisement information (such as a television) would also have an entry for inputting advertisement information. Examiner considers the memory device above to be an advertising information memory device. Examiner considers the set-top box to be a microprocessor (Column 9, Lines 27-38). "In order to allow for change of consequence" merely specifies intended use. Structure with functionality should be claimed, not reasons for implementing. Further, examiner does not understand "change of consequence", and interprets any change as meeting the claim language. Thus, a television remote control as referenced by Gerszberg (Column 9, Lines 31-33) would be capable of providing a change (such as changing the channel) as stated in the claim.

Regarding claims 43 and 44, these claims merely specify intended use. The television of Gerszberg is capable of showing a video display of requested information (television programming) and advertising information simultaneously (Column 4, Lines 5-13 and Column 12, Lines 13-16 and 38-40).

Regarding claims 46-49, Gerszberg shows a user device as being any of the following: a computer (Column 5, Lines 35-38), a telephone or videophone (Column 5, Lines 35-38), or a remote control/phone combination unit (Column 3, Lines 2-4). Gerszberg also teaches a printer as being connected to a videophone (Column 7, Line 55). Claim 28 merely specifies intended use.

Regarding claim 51, Gerszberg teaches the ISD to act as a multiplexer (Column 2, Lines 59-60).

Regarding claims 52, 53, 55, and 56, Gerszberg teaches the communication network as being a telephone network (the communication in this case involves the transmitting of audio to the television) (Column 3, Lines 4-10). Gerszberg also teaches a wide area network such as the Internet as being available (Column 7, Line 3).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg (U.S. Patent No. 6,292,210).** Gerszberg teaches both the requested and advertising information as having video, but doesn't specify the advertisements as having sound. Official notice is taken that it is well known to add sound to a video advertisement shown on a television. Reference is drawn to everyday television commercials as having both video and audio. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include audio in the advertisements of Gerszberg. This would allow for a better understanding of the advertisement, as it could be heard as well as seen.

8. **Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg (U.S. Patent No. 6,292,210) in view of Boylan (U.S. Pub. No. 2004/0194138).** Gerszberg doesn't specify the advertisements shown on the television as being selectable. Boylan teaches an interactive program guide on a television that has user-selectable advertisements (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow users to select which advertisements to view. This would allow for more sales to be made, as users are only looking at advertisements that interest them.

Response to Arguments

Regarding the 112, first paragraph rejection of recently canceled claim 24, Applicant points to page 4 of the description for information regarding the term "change of consequence". No further clarification was found on page 4. However, "change of consequence" on pages 5 and 9 are noted, yet the meaning of the phrase is unclear given the context. Therefore, the rejection still stands for newly added claim 41, which contains the limitations of recently canceled claim 24.

Regarding the 102(e) rejections of the above claims, Applicant argues the difference in operation of the art as opposed to the invention. Applicant fails to show where the art fails to meet specific claim language. The claim interpretations or obviousness conclusions of the examiner are not convincingly challenged either. Thus, the 102(e) and 103 rejections still stand.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER